

Serial No.: 10/743,443
Amendment B dated September 22, 2008
Response to final Office action dated July 23, 2008

Remarks

Claims 1, 3, 5-16, 18, and 20-33 are pending and at issue in the present application. The present amendment cancels claim 34 and amends claims 13, 14, 16, 28, and 29.

No new matter has been introduced by the present amendments, support for which can be found in the present application at least on page 3, lines 18-25 and page 6, lines 7-20, which disclose automatically jumping to and displaying a representation related to a consequent step without direct interaction between a user and a computer system; page 3, lines 3-8, which discloses a computer controlled and directed surgical procedure; and page 5, lines 22-25, which provides an example of a means for controlling a display unit.

The applicants respectfully traverse the rejection of the claims at issue under 35 U.S.C. § 103(a) as obvious over Van Der Brug U.S. Patent No. 5,954,648 ("Van Der Brug") in view of Malackowski et al. U.S. Publication No. 2003/0093103 ("Malackowski") further in view of Iliff U.S. Publication No. 2001/0012913 ("Iliff").

As an initial matter, the applicants respectfully request reconsideration of the finality of the present rejection and withdrawal thereof as premature under MPEP § 706.07(d). MPEP § 706.07(a) sets out the conditions that must be met before an Office action is made final, stating: "actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)." The pending Office action introduces Iliff as a new ground of rejection to teach "identifying a particular step within the multi-step procedure," as recited by claim 1, and "means for identifying a particular step within the multi-step procedure," as recited by claim 16. See Office action pages 3 and 8. Referring to claim 1, the introduction of Iliff was not necessitated by any amendment of the claims because the above recited limitation of claim 1 was amended to incorporate the substance of claim 2 and to clarify that the "procedure" referred to the "multi-step procedure" recited in the preamble. Claim 16 was similarly amended. Further, the applicants assert that Van Der Brug and Malackowski, the applied art in the previous Office action, did not disclose or suggest the original claim limitations

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recited by claims 1 and 16 of "identifying a context within the procedure" or "a first circuit that identifies a context within the procedure," respectively, as discussed in detail in the prior Amendment A. Therefore, Iliff was introduced as a new ground of rejection that was not necessitated by applicant's amendment. Further, Iliff was not submitted in an information disclosure statement submitted by the applicants. Therefore, the finality of the present rejection is premature and should be withdrawn.

Referring to the rejections, the applied references do not disclose or suggest a method of determining a consequent step within a multi-step procedure comprising the steps of identifying a particular step within the multi-step procedure, identifying a component usable in the procedure, determining the consequent step within the procedure based on the identity of the component and the particular step, and displaying a representation related to the consequent step on a display unit, as recited by claims 1, 3, 5-15, and 31-33.

Further, the applied references do not disclose or suggest a system to determine a consequent step within a multi-step procedure that includes means for identifying a particular step within the multi-step procedure, means for identifying a component usable in the procedure, means for determining the consequent step within the procedure based on the identity of the component and the particular step, and means for controlling a display unit to display a representation related to the consequent step, as recited by claims 16, 18, and 20-30.

Rather, Van Der Brug discloses an image guided surgery system that tracks the position of a surgical instrument in an operating area, and Malackowski discloses a surgical tool system that receives data from a surgical tool that includes a handpiece and various accessories attached to the handpiece and calibrates the surgical tool system based on the data.

Further, Iliff discloses an automated disease management system that manages patient medical records, obtains health measurements from the patient, evaluates and assesses the progress of the patient's disease, reviews and adjusts therapy to optimal levels, and gives the patient medical advice for administering treatment and handling symptom flare-ups and acute episodes of the disease. See, e.g., Iliff ¶ 120. The automated disease management system includes a "Health

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Assessment" task that decides a next action to take for a patient, for example, refer the patient out of the system, refer the patient to a diagnostic module for diagnosis of a new symptom, or determine a next therapy step for the patient. See, e.g., Iliff ¶ 131. The "Health Assessment" task makes such decisions based on inputs from the patient, such as patient health measurements received through a dialog box of a computer application, and various algorithms that process inputs from the patient along with various tables and databases that include information relating to symptoms, treatments, patient preferences, etc.

In the present Office action the examiner concedes that Van Der Brug and Malackowski do not disclose a step of or means for identifying a particular step within a multi-step procedure and introduces Iliff to teach such limitations. See Office action pages 3 and 8. However, the examiner also argues that Van Der Brug discloses a step of or means for identifying a component useable in the procedure and that Malackowski discloses a step of or means for determining a consequent step within the procedure based on the identity of the component and the particular step. *Id.* The applicants traverse these arguments because it is improper to argue that Van Der Brug and Malackowski disclose or suggest steps of or means for that are directly dependent on an admittedly undisclosed limitation. Specifically, because Van Der Brug and Malackowski do not disclose or suggest a step of identifying a particular step within a multi-step procedure, it follows that such references do not disclose or suggest the steps recited by claim 1 of identifying a component usable in the procedure, determining the consequent step within the procedure based on the identity of the component and the particular step, and displaying a representation related to the consequent step on a display unit. Similarly, because Van Der Brug and Malackowski do not disclose or suggest means for identifying a particular step within a multi-step procedure, it follows that such references do not disclose or suggest the limitations recited by claim 16 of means for identifying a component usable in the procedure, means for determining the consequent step within the procedure based on the identity of the component and the particular step, and a display unit that displays a representation related to the consequent step.

Further, Iliff does not cure these deficiencies of Van Der Brug and Malackowski. More

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specifically, Iliff does not disclose or suggest a step of or means for identifying a component usable in the procedure and determining a consequent step within the procedure based on the identity of the component and the particular step. Rather, Iliff discloses a disease management system that decides a next action to take for a patient based on information from the patient entered via a computer application and various algorithms.

Therefore, the applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of all of the claims at issue.

In addition to the above, none of the applied references disclose or suggest a step of or means for identifying a particular location of a component, wherein a step of or means for determining a consequent step is based on the location, the identity of the component, and a particular step, as recited by claims 3 and 18, respectively. In the Office action, the examiner uses Van Der Brug to teach identifying a particular location and uses Iliff to teach determining a consequent step based on the location, the identity of the component, and the particular step. See Office action pages 8 and 9. However, Iliff does not include any disclosure or suggestion of determining a consequent step based on the identity and location of a component. As discussed above, Iliff does not even disclose or suggest the identification of a component, much less the identification of a location of such a component and use thereof to determine a consequent step. In fact, none of the references discloses or suggests determining a consequent step in a multi-step procedure based on a location of a component. For this additional reason, applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of claims 3 and 18.

Further, with respect to claims 13 and 28 none of the applied references disclose or suggest a step of or means for automatically jumping to and displaying a representation related to a determined consequent step without direct interaction between a user and a computer system. In the present Office action, the examiner incorrectly argues that Van Der Brug discloses moving to a determined consequent step by equating movement of a surgical instrument within an operating field to movement to a consequent step within a multi-step procedure. See Office action pages 7 and 12. Further, the Office action erroneously argues that Iliff discloses a step of moving to a consequent

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step without direct interaction from a user (see Office action page 14), when in fact, the process of determining a next action to take for a patient in Iliff actually requires a considerable amount of direct user interaction, such as, requiring a user to interact with a computer application and enter health measurements. Claims 13 and 28 have been amended to further clarify these differences from the applied references. Consequently, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 13 and 28 and allowance thereof.

Referring to claims 14 and 29, none of the applied references discloses identifying a particular step within a multi-step computer controlled and directed surgical procedure. Iliff was introduced in the Office action to teach a multi-step procedure, but such procedure in Iliff is not a computer controlled and directed surgical procedure. Further, while Van Der Brug and Malackowski are generally directed to surgical procedures, neither reference discloses identifying a particular step within a multi-step computer controlled and directed surgical procedure, as required by claims 14 and 29. For this additional reason, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 14 and 29 and allowance thereof.

For at least the above reasons, applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of all of the claims at issue. An early indication of allowance is requested.

If there are any issues remaining that can be resolved by telephone, the examiner is invited to call the undersigned.

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Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 C.F.R. §§ 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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By: 

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Reg. No.: 57,310